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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/916,872 | 07/26/2001 | Hidemasa Kitagawa | NAK1-AZ69r | 3423 |

7590

09/04/2002

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EXAMINER

KINDRED, ALFORD W

ART UNIT

PAPER NUMBER

2172

DATE MAILED: 09/04/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/916,872

Applicant(s)

KITAGAWA ET AL.

Examiner

Alford W. Kindred

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27,29,30,33 and 34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-27 is/are allowed.
- 6) ☒ Claim(s) 29,30,33 and 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: Amendment B, filed 6/11/02.
2. This amendment is not in proper format. All amendments are made relative to the original patent which means that all added claims should be underlined in their entirety. (old Rule 1.121, new Rule 1.12 (h) and 1.173 (d)). The amendment does not include a discussion of the status of claims as required by 37 CFR 1.173 (c). Further, Applicant is reminded that a proper statement of support for claims in the original disclosure which means that the claims in the reissue application must be supported by the disclosure originally filed in the original patent application.
3. The word "unnecssarily" is incorrectly spelled in the declaration, it should read "unnecessarily".
4. Applicant indicates in the declaration that the error is as follows:

--"these claims unnecessarily recite the data conversion apparatus to be used as a data transmitting apparatus . . . remove this . . .".

However examiner finds the above language in claim 33 (i.e. "data transmitting apparatus . . .") and therefore the error still exist.
5. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.
6. Claims 1-15 are rejected as being based upon a defective reissue applicant under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

7. Receipt of an appropriate supplemental oath/declaration under 37 CFR

1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

8. There is written consent to the filing of the reissue application by the assignee but the written consent is not signed by a party authorized to act on behalf of the assignee. The consent must be signed by someone empowered according to the rules stated in MPEP 324. Mr. Kitagawa does not qualify, because "Authorized signing Officer" as the title below the signature is proper.

9. The citing of a foreign priority does not make a "claim" for foreign priority.

10. Applicants have not submitted an offer to surrender original Patent. The original Patent must be surrendered prior to allowance.

--The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 29 and 33 recites the limitation "the data transmitting apparatus" in the preamble. There is insufficient antecedent basis for this limitation in the claim.

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13. Claims 1-27 are allowed.

The following is an examiner's statement of reasons for allowance: the prior art of record fails to teach and/or suggest "document storing means for storing a plurality of documents each of which includes at least a character string and at least a piece of image information . . . supplementary design storing means for storing a list of supplementary designs with serial numbers respectively related to the supplementary designs . . . displaying image element generating means for reading the character string and the piece of image information one at a time from the document storing means and converting the character string . . .," coupled with "supplementary design adding means for reading supplementary design corresponding to the piece of link destination information specifying the other document as the link destination from the supplementary design storing means . . .".

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

15. Claims 29-30 and 33-34 are rejected under 35 U.S.C. 102(e) as being anticipated by ***Leone et al.***, US # 5,745,360.

As per claims 29-30 and 33-34, Leone *et al.* teaches “document storing means . . .” (see col. 5, lines 1-15 “character strings at least one of which contains a piece of link . . .” (see col. 4, lines 6-40) “display image generating means . . .” (see col. 9, lines 20-67) “displayed on the plurality of data receiving apparatuses . . .” (see fig. 8—sheet 12 of 12) “identifier adding means for adding . . .” (see col. 12, lines 1-65 and col. 11, lines 50-67).

--**Leone et al.** teaches “reception means for receiving signal of a move button on a remote control . . . focus control means for controlling the focus . . .” (see figure 2, sheet 2 of 12 and figure 4, sheet 5 of 15, whereas **Leone’s** teachings of a keyboard reads on applicant’s disclosure of a remote control used to control a focus element; both are used to remotely control the display and processing of image data remotely).

16. Claims 29-30 and 33-34 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35

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U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Claim 29 of the reissue case is broader than claim 1 and 13 of the original case (i.e. "transmitting apparatus . . .").

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Conclusion

17. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703)-746-7239 (**formal** communications intended for entry),

Or:

(703)-746-7240 (**informal** communications labeled **PROPOSED** or
DRAFT).

Hand-delivered responses should be brought to:

Sixth Floor Receptionist, Crystal Park II, 2121 Crystal Drive, Arlington, VA.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to

Alford Kindred, whose telephone number is (703)-305-3802 and can normally be reached Monday-Friday from 8:30 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu, can be reached at (703)-305-4393.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is

(703)-305-3900


Alford W. Kindred